

REMARKS

REJECTIONS UNDER 35 U.S.C § 112

Claims 1-30 were rejected under 35 U.S.C § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-6, 15-16, 24-25, and 30 have been canceled. Thus, the rejection of these claims is moot. The Office action states that the preambles of independent claims 1, 12, 20, and 28 lack sufficient antecedent basis. For at least the foregoing reasons, the applicant traverses the Examiner's rejection.

The applicant respectfully submits that the Examiner's use of "insufficient antecedent basis" does not accurately characterize the intended rejection. As applicant understands the rejection, the Examiner is rejecting the independent claims because the preambles contain only the phrase "a method comprising" or "an apparatus comprising." Accordingly, applicant points to the Manual of Patent Examining Procedure (MPEP), § 2111.02, which states:

"If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).

Thus, applicant respectfully submits that neither the MPEP nor applicable case law requires the preamble to define the subject matter of the claim. Therefore, the applicant respectfully requests that the Examiner allow claims 1, 12, 20, and 28.

Claims 2-4 and 7-11 depend from claim 1. Claims 13-14, and 17-19 depend from claim 12. Claims 21-23 and 26-27 depend from claim 20. Claim 29 depends from claim 28. Dependent claims necessarily include the limitations of the claims from which they

depend. Therefore, the applicant respectfully requests that the Examiner allow claims 2-4, 7-11, 13-14, 17-19, 21-23, 26-27, and 29.

REJECTIONS UNDER 35 U.S.C § 101

The Examiner rejected claims 1-30 under 35 U.S.C. § 101 for failing to define a concrete, useful, and tangible result. In response, the applicant has amended independent claims 1, 12, 20, and 28 and submits that claims 1, 12, 20, and 28 recite statutory subject matter. Accordingly, the applicant respectfully requests that the Examiner allow independent claims 1, 12, 20, and 28. Given that dependent claims 2-4, 7-11, 13-14, 17-19, 21-23, 26-27, and 29 depend from independent claims reciting patentable subject matter, the applicant further requests that the Examiner allow dependent claims 2-4, 7-11, 13-14, 17-19, 21-23, 26-27, and 29.

REJECTIONS UNDER 35 U.S.C § 103

Claims 1-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,687,605 issued to Wako (*Wako*). Claims 5-6, 15-16, 24-25, and 30 have been canceled. Therefore, the rejection of these claims is moot. The applicant respectfully submits claims 1-4, 7-14, 17-23, and 26-29 are not obvious in view of *Wako* for at least the reasons described below.

Claim 1 recites, in part, the following:

receiving as an input to a digital telephonic device one or more digits of a candidate communication number;
searching a database located in the telephonic device for a communication number corresponding to the one or more digits of the candidate communication number;

locating within the database a communication number corresponding to the one or more digits of the candidate communication number;

Independent claims 12, 20 and 28 recite similar limitations. The Office action cites *Wako* as disclosing these limitations. *Wako* discusses a navigation system that uses a telephone number as a sorting mechanism to search for map and address information using a CD-ROM. Rather than searching a CD-ROM, claim 1 recites searching a database **located in the telephonic device** for a communication number. *Wako* does not disclose or suggest a database located in a telephonic device nor does it teach searching a database located in a telephonic device. Therefore, *Wako* fails to disclose at least one limitation of claim 1. Thus, the applicant respectfully submits claims 1, 12, 20, and 28 are not obvious in view of *Wako*.

Claims 2-4 and 7-11 depend from claim 1. Claims 13-14 and 17-19 depend from claim 12. Claims 21-23 and 26-27 depend from claim 20. Claim 29 depends from claim 28. Given that dependent claims necessarily include the limitations of the claims from which they depend, the applicant submits that claims 2-4, 7-11, 13-14, 17-19, 21-23, 26-27, and 29 are not obvious in view of *Wako*.

CONCLUSION

For at least the foregoing reasons, the applicant submits that the rejections have been overcome. Therefore, claims 1-4, 7-14, 17-23, and 26-29 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Applicants have included a copy of all claims in the attached index for the Examiner's convenience.

Please charge any shortages and credit any overcharges to our Deposit Account
number 02-2666.

Respectfully submitted,
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